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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,264	03/17/2005	Pierre Degott	5612	2267
26/936 7590 04/15/2010 SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 100 SILVER SPRING, MD 20910				
EXAMINER				
FAISON GEL, VERONICA FAYE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
04/15/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,264

**Applicant(s)**

DEGOTT ET AL.

**Examiner**

VERONICA FAISON GEE

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-60 is/are pending in the application.
- 4a) Of the above claim(s) 46-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-45 and 57-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**ETAILED ACTION**

***Election/Restrictions***

1. Claims 46-56 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9-25-09.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26-45 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (US Patent 6,786,954).

Lee et al teach an ink composition useful for printing markings on security documents that are relatively resistant to counterfeiting. The reference further teaches that the markings formed of the ink composition has a spectral response that deviated from a predicted spectral response of components of the ink composition, so that it becomes difficult to reverse-engineer the ink composition from the marking (abstract, col. 3 line 55-col. 4 line 17). The reference also discloses that non-linear mixing or combining of pigment spectra, or a spectral response of a mixture which deviates from a predicted linearly additive spectral response of the individual spectral responses of the

components of the mixture is a known phenomenon (col. 4 lines 42-46). The difficulty of counterfeiting would increase where there are more than two inks in the set of inks, for example a third ink comprising a third pigment not in itself fluorescent but capable of enhancing the strength of the short wavelength part of the spectrum of the first pigment. Then the mixture of the three pigments would produce the spectrum which includes increased intensity thus adding immensely to the difficulty of the counterfeiting a pattern (col. 5 lines 4-12). The reference also teaches that the ink composition can be applied to an object, the object can include a plurality of the markings and each marking can be a microdot in order to increase difficulty of counterfeiting the marking. The object can include two or more markings respectively of different inks having different spectral responses (col. 5 line 51-col. 6 line19). The reference discloses that the ink composition can be used in general for document security, counterfeit detection and physical access control such as trademark and label verification, passport and visa verification, check verification and identification documents (col. 7 lines 15-40). Lee et al disclose that the method of implementing difficult is printing using ink jet ejector of pigments and phosphors having the nonlinear color mixing characteristics, to make arrays of colored microdots each dot having a unique spectral response (col. 9 lines 54-62, col. 10 lines 13-29). The reference discloses that while not to be limiting, nonlinear spectral response combining can be achieved by utilizing inks which exhibit multiple fluorescent absorption and re-emission bands. Pigments/dyes which block out wavelengths near fluorescent absorption lines will affect the spectral response at wavelengths away from where their pigments/dyes directly effect the absorbed or

reflected light. Light emitted by one fluorescent band conversely can be absorbed and re-emitted at other colors. The characteristics of a fluorescent response of a dye can be made to change depending upon the presence or absence of trace non-light emitting chemicals. Conventional press and roller contact printing techniques can also be used to print security labels based on this combinatorial mixing technology (col. 12 lines 42-52). The reference remains silent as to whether the colorants are selected with the specific properties set forth in claim 26. However, when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112-2112.02. Therefore it would have been obvious to one of ordinary skill in the art the composition as taught Lee et al would have colorant with the properties as set forth in claim 26 absence tangible evidence to the contrary.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/  
Supervisory Patent Examiner, Art Unit 1793

/Veronica Faison-Gee/  
Examiner, Art Unit 1793